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11-D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,911

11/21/2003

Bryan M. Kelly

BLLYP001.US13

4013

45965 7590 01/30/2008  
TECHNOLOGY & INTELLECTUAL PROPERTY  
STRATEGIES GROUP PC (dba TIPS GROUP)  
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EXAMINER

HSU, RYAN

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

01/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/719,911

Applicant(s)

KELLY ET AL.

Examiner

Ryan Hsu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely-filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

In response to the amendments filed on 7/30/07, no claims have been amended. Claims 1-12 are pending in the current application.

***Priority***

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. However, Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 07/956,057, 08/176,862, 08/995,649, 09/351,408, 09/695,712, and 10/176,100 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The applications previously filed do not disclose or suggest or mention the use of "an award server" to provide awards based on one or more criteria wherein the award server includes "a CPU a software, physically separated from said plurality of player machines and coupled with said plurality of player-machines for digital communication

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therewith, wherein said digital communication includes game information and award information associated with said at least one game”.

***Terminal Disclaimer***

The terminal disclaimer filed on 7/30/07 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US patent # 5,816,918 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Objections***

Claim 1 is objected to because of the following informalities: applicant has spelled the word sufficient as “suffcient”. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Kelly et al. (US 5,816,918).**

Regarding claim 1, Kelly et al. discloses a game system, the game system comprising: a plurality of physically separated player-machines, wherein each physically separated player-machine includes its own CPU and software for allowing a player to play at least one game that requires sufficient skill such that it is not primarily a game of chance (*see games [272] of Fig. 5a and the related description thereof*), wherein the player is entitled to play at least one game due to an economic consideration and is adapted for developing digital information resulting from

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play of the at least one game (*see monetary input [104] of Fig. 3 and the related description thereof*). Additionally, Kelly discloses an award server that includes a CPU and software, physically separated from the plurality of player-machines and coupled with the plurality of player-machines for digital communication therewith, wherein the digital communication includes game information and award information associated with at least one game (*see server [108] and prize selection unit [11] of Fig. 3 and the related description thereof*).

Regarding claim 9, Kelly et al. discloses a method for a game system comprising: allowing a player to play at least one game that requires sufficient skill such that at least one game is not primarily a game of chance (*see games [272] of Fig. 5a and the related description thereof*), and at least one game being played on one of a plurality of physically separated player-machines in a game system (*see Fig. 2-3 and the related description thereof*). Additionally, Kelly's method discloses wherein each of the plurality of physically separated player-machines is adapted to develop digital information resulting from play of at least one game and for being in digital communication with other physically separated player-machines, wherein the player is entitled to play at least one game due to an economic consideration (*see 'monetary input' [104] of Fig. 3 and the related description thereof*). Furthermore, Kelly's system discloses digitally communicating with an award server including its own CPU and software by a plurality of physically separated player-machines wherein the award server is physically separated from the plurality of physically separated player-machines and the digital communication includes game information and award information associated with at least one game (*see server [108] of Figs 3-4 and the related description thereof*).

Regarding claims 2 and 10, Kelly discloses a system wherein the digital communication is over a network wherein the plurality of player-machines is coupled to the award server (*see Figs. 3-4 and the related description thereof*).

Regarding claims 3-4 and 11-12, Kelly discloses a system wherein the network includes various options to allow for networked communication between the different devices. As disclosed by Kelly, network device [24] can be implemented as any one of many devices well known to those skilled in the art such as a network interface card coupled to a main bus of the system, a telephone modem, a cable modem, a direct network connection or other device for communicating information according to standard network or modem protocols (*see col. 12: ln 30-40*). Therefore Kelly discloses a system wherein the network communication device inherently uses a common serial transmission protocol and thus it would encompass implementation of the standard protocol known as RS-232 (*in arguendo please refer to wikipedia's definition of RS-232 as a standard serial protocol that is used for communication in modems*).

Regarding claim 5, Kelly discloses an award server that provides awards based on one or more criteria, selected from a group consisted of: a game result; a progressive score; a completion of a specific task; an attainment of a specific goal; and a number of players playing (*see col. 15: ln 25-44*).

Regarding claim 6, Kelly discloses a game system wherein the progressive score is associated with a progressive bonus that is based on contributions made by a plurality of physically separated player-machines, and wherein the progressive score can be incremented or

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decremented based on a multiplier associated with the contributions (*see col. 20: ln 16-col. 21: ln 48*).

Regarding claim 7, Kelly discloses a game system wherein the contributions are based on one or more events comprising: consideration generated from at least one of the plurality of physically separated player-machines (*see col. 16: ln 20-67*); and attainment of at least one of the plurality of physically separated player-machines; and attainment of at least one pre-determined goal by at least one player playing at the plurality of physically separated player-machines (*see Figs. 5 and 7 and the related description thereof, col. 18: ln 22-37*).

Regarding claim 8, Kelly discloses a game system wherein the award server provides non-monetary awards (*see col. 15: ln 26-44*).

#### ***Response to Arguments***

Applicant's arguments filed 7/30/07 have been fully considered but they are not persuasive. The arguments that the '918 patent is not prior art is incorrect since as has been shown above the instant application has not met the requirements of claiming the benefit of patent 5,292,127 with a filing date of 10/2/1992. Therefore the rejection previously stated is still considered prior art and the instant claims stand rejected.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Hsu whose telephone number is (571)272-7148. The examiner can normally be reached on 9 :00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



RH

October 2, 2007



ROBERT E. PEZZUTO  
SUPERVISORY PRIMARY EXAMINER